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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/673,894

09/29/2003

Mohammad Hossein Zarrabizadeh

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7590

04/06/2009

Docket Administrator - Room 2F-192

Alcatel-Lucent USA Inc.

600-700 Mountain Avenue

Murray Hill, NJ 07974

EXAMINER

AZARIAN, SEYED H

ART UNIT

PAPER NUMBER

2624

MAIL DATE

DELIVERY MODE

04/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/673,894	Applicant(s) ZARRABIZADEH, MOHAMMAD HOSSEIN	
	Examiner Seyed Azarian	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36 and 38 is/are allowed.
- 6) ☒ Claim(s) 1-35 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/29/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

1. Applicant's arguments, filed 1/6/2009, see page 1 through page 24 of the remarks, with respect to the rejection of claims 1-6, 9-35 and 39 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, due to the newly developed interim guidelines for 35 USC 101, (In re Bilski, 88 USPQ2d 1385 (Fed. Cir. 2008)) regarding process claims, claims 1, 20, 30 and 39 are rejected.

Claim Rejections - 35 USC § 101

2. Claims 1-21, 26, 28, 30, 31 and 33 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. The Federal Circuit, relying upon Supreme Court precedent, has indicated that a statutory "process" under 35 U.S.C. 101 must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. This is referred to as the "machine or transformation test", whereby the recitation of a particular machine or transformation of an article must be impose meaningful limits on the claim's scope to impart patent-eligibility (See Benson, 409 U.S. at 71-72), and the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity (See Flook, 437 U.S. at 590"). For example "a method for use in watermarking a video signal, the method comprising the steps of". While the claims recite a series of steps or acts to be performed, the instant claims neither transform underlying subject matter nor positively tie to particular machine that accomplishes the claimed method steps. In order for process to be "tied" to a particular machine, the structure of a particular machine should be positively recited in a step or steps significant to the basic inventive concept, and not just in association with statements

of intended use or purpose, insignificant per or post solution activity, or implicitly. Appropriate correction is required. *In re Bilski* 88 USPQ2d 1385 (Fed. Cir. 2008).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-39 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-58 of copending Application No. 10,673,892.

Each of the limitation set forth in the claims of the instant application is defined in the claims of copending Application.

As an example consider claim 1, of current application, compared to claim 1, of copending application, it disclose: A video signal including additional information therein, said video signal being characterized in that at least a portion of said additional information has been impressed upon a chrominance portion of said video signal by placing it in at least one selected

Art Unit: 2624

bit position of a value derived from an average of said chrominance portion over a block of said video signal. Also consider claim 2, of current application, compared to claim 12, of copending application, it disclose: The invention as defined in claim 1 wherein said block of said As an example consider claim 1, of current application, compared to claim 1, of copending application, it disclose: signal is in a reduced resolution format such that for each 2.times.2 luminance block of an original version of said As an example consider claim 1, of current application, compared to claim 1, of copending application, it disclose: signal, had said original version of said As an example consider claim 1, of current application, compared to claim 1, of copending application, it disclose: signal been in 4-4-4 representation, there remains only one Y, one U, and one V value.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

REASONS FOR ALLABLE CLAIMS

5. The reasons for allowable claims, set fort in the previous office action dated on 11/21/2007 are not repeated herein, but are incorporated by reference. As applicants properly point out in the previous remark, the prior art fails to disclose the claim limitation.

Contact Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seyed Azarian whose telephone number is (571) 272-7443. The examiner can normally be reached on Monday through Thursday from 6:00 a.m. to 7:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella, can be reached at (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR.

Status information about the PAIR system, see [http:// pair-direct.uspto.gov](http://pair-direct.uspto.gov). Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Seyed Azarian/

Primary Examiner, Art Unit 2624

*Group Art Unit 2624
March 28, 2009*